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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,247	12/05/2000	Geoffrey K. Crawshaw	642932/002	8100
7590	09/20/2004		EXAMINER	
STROOCK & STROOCK & LAVAN LLP 180 Maiden Lane New York, NY 10038			MCALLISTER, STEVEN B	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/730,247	CRAWSHAW ET AL.
	Examiner	Art Unit
	Steven B. McAllister	3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 30 June 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 21-77 is/are pending in the application.
- 4a) Of the above claim(s) 66-77 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 21-65 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Election/Restrictions

Newly submitted claims 66-77 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the invention of claims 66-77 is drawn to a method of generating billing data. The invention previously examined (cls. 1-10) is drawn to a system for generating billing data.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 66-77 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 29, 30, 47 and 61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 29, 30, 47 and 61 recites that data "may" be provided. This does not provide a positive recitation.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 38 and 39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 38 recites a processor configured to store data in a relational database. However, the specification as understood by the examiner does not enable storing data in a database in the processor. As understood by the examiner, the data is stored in medium such as a hard drive. One of ordinary skill in the art would not have been able to make the claimed invention without undue experimentation.

Note Regarding Examination

In order to interpret claims 21-65 in a manner consistent with 35 USC 101, the system of the claims is interpreted as an apparatus.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 21, 22, 24-55 are rejected under 35 U.S.C. 102(e) as being anticipated by Haseltine et al (6,578,015).

Haseltine et al show one or more processors capable of receiving first data related to a customer; retrieving a conversion parameter based on a predetermined parameter specific to the customer; generating second data by converting the first data based on the retrieved parameter; and storing the first data, the second data and the conversion parameter.

As to claims 22, Haseltine et al show the processor based in a single computer.

As to claims 24-39, the processors of Haseltine et al are capable of enabling the recited steps.

As to claims 27, 28, 35 and 36, it is noted that the limitations are directed only to the data used by the apparatus and not toward that apparatus and therefore, as part of the intended use only, do not further limit the apparatus.

As to claims 29 and 30, it is noted that the external data may be electronically provided to the customer via network.

As to claim 31, it is noted that Haseltine et al contemplates providing only a billing summary and not providing the full detailed statement.

As to claim 40, Haseltine shows a server system connected via the internet and operable in connection with software to receive data related to a customer; to retrieve a conversion parameter stored for the customer based upon predetermined parameter specific to the customer; to generate second data by converting the first data using the conversion parameter; and to store the first data, second data and conversion parameter. It is noted that the recitation "operable in connection with software to ..." is interpreted as intended use only, since software performing the steps is not claimed. Rather the claims recite that the servers are operable or capable of performing the recited steps in combination with software.

As to claim 41, since the user is able to enter the first data and view the second data, and the system is software-based, it is inherent that software enabling those functions is included.

As to claim 42, both special purpose software (e.g., bill formatting) and general purpose software (e.g., operating system) is included.

As to claim 43, it is noted that any software is downloadable to a remote computer.

As to claims 44, 48-55, it is noted that the apparatus in connection with software is capable of performing all recited steps.

As to claims 45 and 46, it is noted that the limitations are directed only to the data used by the apparatus and not toward that apparatus and therefore, as part of the intended use only, do not further limit the apparatus.

As to claim 47, it is noted that the external data is provided to the customer via the internet.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haseltine et al.

Haseltine et al show all elements except one or more server coupled via a network. However, to use a plurality of servers coupled by a network is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to modify the apparatus of Haseltine et al by providing such an architecture in order to provide a more scalable system.

Claims 56-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haseltine et al in view of Brodsky et al (6,751,597).

Haseltine et al show a server system connected to the internet and capable of enabling a user to enter first data related to a customer and view second data related to

a customer; of receiving the first data from the user, retrieving a conversion parameter for the customer based on a parameter specific to the customer (e.g., that the customer is late with payment and receives a different template), generating second data by adjusting the first data based on the conversion parameter, and providing the second data to the user; and of storing the data and conversion parameter. Haseltine et al do not show that the server system uses a first, second and third server. Brodsky et al show breaking functionality up between a first server comprising a web server; a second server comprising an application server; and a third server comprising a database server. It would have been obvious to one of ordinary skill in the art to modify the apparatus of Haseltine by breaking the functionality into three servers, as taught by Brodsky et al in order to ease the load on each server. (It is further noted that the "configured to" statements are interpreted as reciting intended use only.)

As to claim 57, it is noted that the limitation regarding the data does not pose a further limitation to the apparatus. Additionally, as broadly claimed Haseltine et al in view of Brodsky et al show the first data being internal data and the second data being external data. As above, it is further noted that the first server is a web server.

As to claims 58 and 59, it is noted that Haseltine et al in view of Brodsky et al show all elements.

As to claim 60, Haseltine et al in view of Brodsky et al inherently show time and expense data since they show billing for phone service and credit cards, both of which contain billing data time and expense elements. As to having it entered by an employee, it is notoriously old and well known in the art to have an employee enter

data. It would have been obvious to one of ordinary skill in the art to modify the apparatus of Haseltine et al by doing so in order activate the system.

As to claim 61, Haseltine et al in view of Brodsky et al show providing the second data via the internet.

As to claim 62, the first server has general purpose software (such as the operating system) and the second server has general purpose software and special purpose software (e.g., bill preparation software).

As to claims 63 and 64, it is noted that Haseltine et al in view of Brodsky et al show numerically adjusting the first data (since the data is essentially all zeros and ones) by performance a mathematical calulation on the first data based on the conversion parameter.

As to claim 65, Haseltine et al in view of Brodsky et al show adjusting the bill to a particular format.

Response to Arguments

Applicant's arguments filed 3/15/2004 have been fully considered but they are not persuasive.

Applicant argues that Haseltine does not teach retrieving a conversion parameter and generating second data. The examiner respectfully disagrees. The first data as input comprises essentially an order grouping of 1's and 0's, as does the conversion

parameter comprising e.g., the format conversion parameters. An application program applies the format conversion parameter to the first data and generates a substantially new and different third data entity (the “second data”). While some of the data elements may be the same, the first data as a whole has been converted to the second data.

The arguments regarding the Tran 103 rejections are moot, since this rejection has been withdrawn.

It is noted that claims 21, 40 and 56 all recite substantial intended use. In claims 21 and 56, it is noted that the data in, and depending from, the “configure to” phrases are considered to be intended use only. As to claim 40, the apparatus was never claimed in combination with software to perform any task. Rather, it was claimed as “operable” in connection with software. Further, the software was not claimed as causing the recited steps to be carried out.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (703) 308-7052. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steven B. McAllister